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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,337

03/03/2004

Scott Steffensmeier

2602.68249

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48844

7590

06/14/2006

GREER, BURNS & CRAIN, LTD.

ATTN: JAMES K. FOLKER

300 SOUTH WACKER DRIVE

SUITE 2500

CHICAGO, IL 60606

EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

E

Office Action Summary	Application No. 10/792,337	Applicant(s) STEFFENSMEIER ET AL.	
	Examiner James L. Swiger	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 17-18 is/are rejected.
- 7) ☒ Claim(s) 7-13 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

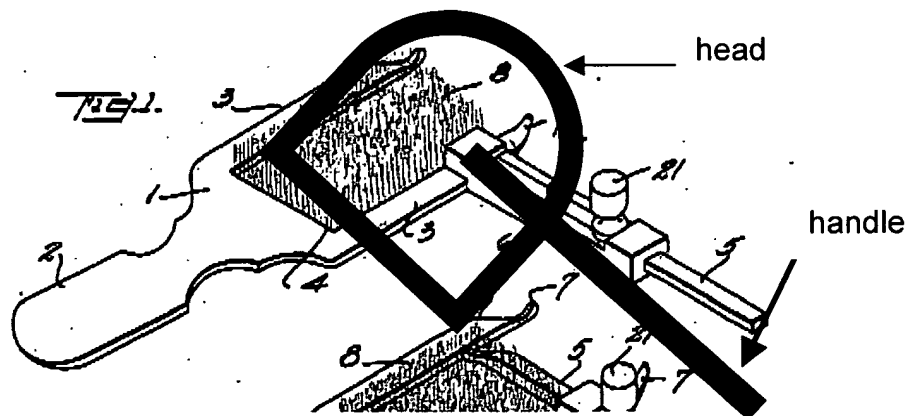
- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, see amendment, filed 3/9/2006, with respect to the rejection of Smith '477 in view of '299 have been fully considered and are persuasive. The rejection under U.S.C. section 103 directed to claims 1, 7-9, and 12 have been withdrawn.

Applicant's arguments filed 3/9/2006 with respect to claims 1-6 (and indeed 6 was incorrectly omitted in the last action) and 17-18 have been fully considered but they are not persuasive. Applicant argues for claims 1-5 that Nessler '518 does not have a channel extending along the tibial sizer in a longitudinal direction that extends through a portion of the head and a portion of the handle. Applicant correctly affirmed in the response that bracket 6 is considered the handle. With respect to the orientation being transverse or longitudinal, this is a matter of how one interprets the reference. If the examiner was referring to (2) as the handle, then (6) would be considered *transverse* in this interpretation. However, collectively (3, 1, and 2) are part of the head, and (6) is the handle. See illustration below.



In the illustration, the a handle is the lower extended portion, while the head is the upper portion. Because of this interpretation, the handle extends *longitudinally*. With regards to a slider extending through both portions, applicant asserts that the channel does not exist. Review again Figs. 1 and 2 of Nessler. Note that slider handle 21 is connected to a sliding portion that extends (5) out the bottom of the handle, and can be *slid* up through the head portion (see second embodiment in Fig. 2). Also in Fig. 2, note the small black box near item 6, showing that there is a space, or a channel, in the absence of the slider bar. Further, how the device is used is a fuctional use. Thus the device is capable of use in taking measurements of a knee.

Applicant is reminded that with regard to the statement of intended use, they do not impose any structural limitations on the claims distinguishable over Nessler, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With regards to claim 17-18, see above statements regarding the reference of Nessler. The device is capable of use with multiple plates, as disclosed by Cloutier '228 (Col. 2, lines 16-20).

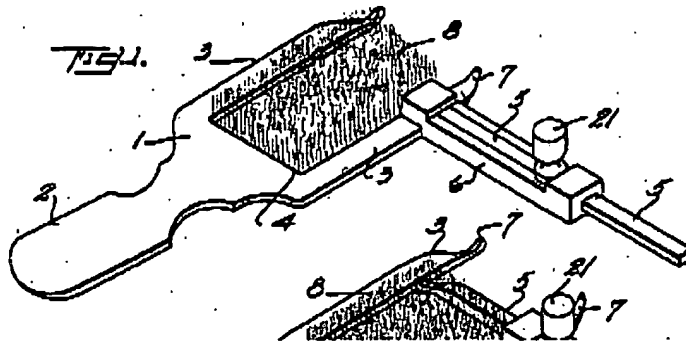
For all of the above reasons, the following rejections still stand as before:

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nessler (U.S. Patent No. 1,962,518). With regard the statement of intended use pertaining to claims 1-5 and other functional statements, they do not impose any structural limitations on the claims distinguishable over Nessler, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Nessler discloses a device having a head (See Fig. 1 below), a handle extending outwardly from the head (6), a channel that extends through at least a portion of the head and handle (Fig. 1), and a slider (5). Nessler also discloses a head that has



a posterior surface that is generally flat (See Fig. 1), a lateral outer surface that is curved (see Fig. 1), and a third medial surface that is generally flat (Fig. 1) and has a cutout portion. Nessler also discloses a hook at the end of the slider (7) capable of making contact with the posterior portion of a proximal tibia, which is cited functionally.

Allowable Subject Matter

Claims 7-13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLS



6/4/00



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER